

In re Patent Application of:
THOMSON ET AL.
Serial No. 09/658,389
Filed: September 8, 2000

REMARKS

Claims 1-76 remain pending in the application with Claims 1-6, 8-10, 12, 13, 15, 17-22, 24-31 and 33-38 being directed to the elected species. Reconsideration of the rejections is requested.

I. The Claim Rejection Under 35 U.S.C. §112, First Paragraph

The Examiner again rejected Claims 8, 9, 19, 28, and 33-38 as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

Applicants again emphasize that the specification and drawings specifically disclose the steering tube clamp 40, with fastener receiving passageways 42b and 42c canted at an angle, e.g. about one to three degrees, accommodated in the clamp receiving passageway 36, and with fasteners/bolts 46a and 46b engaged in the fastener receiving passageways.

As detailed in the previous response, the Examiner has failed to meet the burden of establishing a reasonable basis to question the enablement provided for the claimed invention. A specification disclosure which contains a teaching of the manner of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

The Examiner's assertion that "it would be almost impossible to engage the second fastener receiving passageway 42c without breaking the passageway 36 or the clamp members 40" is made without any acceptable evidence or reasoning which is inconsistent with the teachings of the present specification.

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Accordingly, Applicants maintain that the specification describes the subject matter of the above referenced claims in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the claimed invention, without any undue experimentation.

II. The Double Patenting Rejection Is Improper

The Examiner has now provisionally rejected Claims 1-3, 10, 12, 13, 15, 17, and 20-22 under the doctrine of obviousness-type double patenting over Claims 1-27 of co-pending Patent Application Serial No. 09/658,509 in combination with the Cheng patent. Applicants again maintain that the present claims are directed to patentably distinct aspects of the bicycle stem and that there will exist no improper timewise extension of the right to exclude. Therefore the double patenting rejection is improper and should be withdrawn.

Additionally, independent Claims 1 and 17 recite that respective outer surface portions of the clamp members define the imaginary cylinder and a recess therein for the steering tube, with each clamp member also having at least one fastener receiving passageway therein offset a predetermined distance from an axis of the cylinder. The claims of the co-pending application do not recite such a feature. Also, the Cheng patent does not disclose or teach such a feature, as will be discussed in more detail below with respect to the rejections under 35 U.S.C. §102 and §103. For these additional reasons, the double patenting rejection should be properly withdrawn.

III. The Invention

The invention is directed to a bicycle stem for connecting a bicycle handlebar to a bicycle steering tube. The bicycle stem includes a steering tube clamp in a clamp receiving passageway. The steering tube clamp comprises a pair of

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cooperating clamp members aligned in side-by-side relation and comprising respective outer surface portions defining an imaginary cylinder and a recess therein for the steering tube. Each clamp member also has one or more fastener receiving passageways therein that are offset a predetermined distance from an axis of the cylinder. The steering tube clamp also comprises one or more fasteners extending between corresponding fastener receiving passageways of the pair of clamp members for urging the clamp members together to engage the steering tube and thereby secure the bicycle stem to the steering tube. Additionally, or alternatively, the fastener receiving passageway may be canted at a predetermined angle from parallel to the axis of the cylinder.

IV. The Claims Are Patentable

The Examiner's previous rejection in view of the Lai patent has been withdrawn in view of Applicants' amendments and arguments set forth in the October 30, 2002 Response. Claims 1-6, 10, 12, 13, 15, 17, 18, 20-22, 24-27 and 29-31 have now been rejected in view of Cheng (U.S. 5,477,747) taken alone or in combination with Roddy (U.S. 5,881,606) for the reasons set forth on pages 5-8 of the Office Action. Applicants contend that Claims 1-6, 10, 12, 13, 15, 17, 18, 20-22, 24-27 and 29-31 clearly define over the cited references, and in view of the following remarks, favorable reconsideration of the rejections under 35 U.S.C. §102 and §103 is requested.

Independent Claims 1 and 17 recite a steering tube clamp in the clamp receiving passageway and comprising a pair of cooperating clamp members aligned in side-by-side relation and comprising respective outer surface portions defining an imaginary cylinder and a recess therein for the steering tube. Furthermore, each clamp member also has at least one fastener receiving passageway therein offset a predetermined distance from

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an axis of the cylinder. Similarly, independent Claim 24 includes a pair of cooperating clamp members aligned in side-by-side relation and comprising respective outer surface portions defining an imaginary cylinder and a recess therein for the steering tube, with each clamp member having a plurality of fastener receiving passageways therein offset a predetermined distance from an axis of the cylinder.

The claimed combinations of features are not fairly taught or suggested in the cited references and patentably define over the cited references.

The Examiner has now relied on the Cheng patent as allegedly disclosing a bicycle stem having a steering tube clamp that includes a pair of clamp members having at least one fastener receiving passageway therein offset a predetermined distance from an axis of an imaginary cylinder defined by outer surface portions of the clamp members. However, as discussed above, the claims recite that outer surface portions of the clamp members define the imaginary cylinder, while the clamp members include at least one fastener receiving passageway therein offset a predetermined distance from an axis of the cylinder.

As illustrated in FIGs. 1 and 2 of the Cheng patent, the fastener receiving passageway 30 passes directly along the axis of the cylinder defined by the outer surface portions of the clamp members 28. On page 6 of the Office Action, the Examiner points to the cross-sectional view of FIG. 2 of Cheng to support his position that the passageway is offset from a center axis of the clamp members. However, the Examiner has mischaracterized the actual teachings of the reference in view of the claims.

More, specifically, Applicants point out that the clamp members 28 of Cheng include outer surface portions and shoulders 31 defining reduced diameter portions for accommodating a

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partition member 26 (see the clamp member 28 in the lower right side of FIG. 1 of Cheng). The partition member 26 and the reduced diameter portion can be seen in the cross-sectional view of FIG. 2 relied upon by the Examiner. As can be seen from the actual teachings of the Cheng reference, the outer surface portions of the clamp members 28 define a cylinder having a center axis for which the passageway 30 is aligned. If the Examiner is relying on the reduced diameter portions of the clamp members 28 as meeting the claimed feature of the outer surface portions defining an imaginary cylinder, then the passageway 30 is still aligned with a center axis thereof. Under either interpretation of the Cheng patent, it is clear that the fastener receiving passageway thereof is not offset from the axis, and that independent Claims 1, 17 and 24 define over the Cheng patent.

The Examiner has relied on the Roddy patent as allegedly showing a handlebar clamping portion and a steering tube clamping portion being integrally formed as a monolithic unit. However, nothing in the Roddy patent makes up for the deficiencies pointed out above with respect to the Cheng patent.

There is simply no teaching or suggestion in the cited references to provide the combination of features as claimed. Accordingly, for at least the reasons given above, Applicants maintain that the cited references do not disclose or fairly suggest the invention as set forth in Claims 1, 17 and 24. Furthermore, no proper modification of the teachings of these references could result in the invention as claimed. Thus, the rejections under 35 U.S.C. §102 and §103 should be withdrawn.

It is submitted that the independent claims are patentable over the prior art. In view of the patentability of the independent claims, it is submitted that their dependent claims, which recite yet further distinguishing features are also

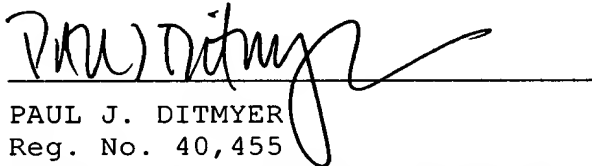
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patentable over the cited references for at least the reasons set forth above. Accordingly, these dependent claims require no further discussion herein.

V. CONCLUSION

In view of the arguments provided above, it is submitted that all the claims are patentable. Accordingly, a Notice of Allowance is requested in due course. If any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: DIRECTOR, U.S. PATENT AND TRADEMARK OFFICE, WASHINGTON, D.C. 20231, on this 11th day of March, 2003.

